

REMARKS

Claims 1-3, 6 and 8-16 are pending. All claims have been rejected under 35 U.S.C. §103(a) as obvious over U.S. Pat. No. 6,497,361 to Mason (hereinafter "Mason") in view of U.S. Pat. No. 6,102,290 to Swartz et al. (hereinafter "Swartz"). Applicant respectfully traverses this rejection. Reconsideration of the present application is respectfully requested.

Independent claims 1 and 16 explicitly require a prompting system that "is configured to present the deactivation prompt after the receipt of the product code by the input device and prior to deactivation of the article." Applicant respectfully submits that this feature of the present invention is neither taught nor suggested by Mason, Swartz or the combination thereof.

On page 3 of the Final Office Action, it is concluded that this feature is anticipated by Mason's "touch-screen display 24" and Mason's "speaker 34." Applicant respectfully disagrees.

As an initial matter, it should be noted that the Examiner's conclusion is not supported by any argument. As shown below, on page 3 of the Office Action, Mason's touch-screen display "24" and speaker "34" are cited with absolutely no reasoning or any citation in Mason on how they read on the above-mentioned limitation in independent claims 1 and 16. The following is a direct quotation of that portion of the Office Action:

"a prompting system 24, 34 configured to present a deactivation prompt to direct a user to position the article for purchase within the deactivation region to effect the security tag deactivation, wherein the prompting system is configured to present the deactivation prompt after the receipt of the product code by the input device"

Final Office Action dated 7/24/2008, page 3, lines 4-8 (emphasis added).

While not cited by the Examiner, the best support for the Examiner's rejection can be found in Mason at column 4, lines 8-19:

In step 98 of FIG. 2, if the system determines that the merchandise that was purchased matches the merchandise placed in the itemization area, then the system will activate the EAS deactivator 42. The item will then be moved into the itemized area 44 for bagging. As discussed above, one way of accomplishing this is to provide an automatic conveyor belt that would position that item in the itemization area and then carry it away once the EAS tag has been deactivated. In another embodiment, the customer manually moves the item from the itemization area to the itemized area, prompted as necessary by touch-screen display 24 and speaker 34. The system then returns to step 92 and repeats the process for the next item.

Mason, Col. 4, lines 8-19.

Nevertheless, Applicant respectfully submits that Mason's disclosure does not anticipate Applicant's claimed interactive prompting system.

Mason discloses a system having (1) an *itemization* area and (2) an *itemized* area. The actions of (i) bar code scanning; and (ii) tag deactivation *both* happen in the itemization area. See Mason, col. 3, lines 16-52. If the item has no bar code, the user enters item codes when the products are within the itemization area, after which the items are deactivated in the itemization area. See Mason, col. 3, lines 56-66. **In either case, there is no movement from scanning/identifying to deactivation and no prompting is done between these steps.** The items are then moved from the itemization area to the itemized area for bagging. See Mason, col. 2, lines 37-44. Since both bar code scanning and tag deactivation happen in the same "itemization" area, no movement or user intervention is required between these steps, and thus a prompt would be unnecessary. Therefore, not only is there no deactivation prompt between the scanning and the tag deactivation, as explicitly recited in Applicant's claimed invention, but none would be necessary or wanted in Mason.

In Mason's invention, it would be counterproductive and illogical to prompt the user when no user intervention is required. The prompts disclosed in Mason at column 4, lines 16-19 take place after deactivation. Therefore, they cannot be "deactivation prompts" and are not "presented prior to deactivation of the article" as explicitly claimed in Applicant's independent claims 1 and 16. For at least this reason, Mason's disclosure does not anticipate the prompting system that "is configured to present the deactivation prompt after the receipt of the product code by the input device and prior to deactivation of the article," as explicitly recited in Applicant's claims 1 and 16.

Furthermore, the addition of Swartz does not cure the above-mentioned deficiencies in Mason. On page 4 of the Final Office Action, Swartz was cited to read on Applicant's "database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags and articles not having attached security tags," as explicitly recited in independent claims 1 and 16. Applicant respectfully submits that these features of the present invention are neither taught nor suggested by Swartz, Mason or the combination thereof.

Swartz merely discloses scanning systems designed to prevent article theft, wherein the security tag at the deactivator is compared to the security tag at time of purchase. If the security tag at the deactivator matches the security tag at time of purchase, deactivation is allowed. Otherwise it is not. See, e.g., Swartz Figs 7(a)(b); 9(a)(b); 12(a)(b); and col. 20, lines 33-48. However, as discussed in detail

below, **Swartz never envisaged situations where the product to be scanned does not have an attached security tag.**

All of the references in Swartz cited by the Examiner, namely claim 1, figures 9-10 and corresponding text, as well as remaining specification not discussed by the Examiner, refer to such anti-theft systems, NOT to non-tagged items. For example, discussing Figure 9 in column 19, lines 22-30, Swartz discloses that value of a symbol (tag) is “stored in memory” during a purchase of an item in “step 186”. During tag removal or deactivation, the symbol is “compared with the symbols of the hanger tags previously stored at Step 186.” (Swartz col. 20, line 5-8.) This prevents a customer “from removing surveillance tags from articles other than those articles purchase. (Swartz col. 20, line 35-37.) Figures 10(a), 10(b) and claim 1 all involve the same subject matter. (Swartz col. 22, lines 49-56; col. 25, lines 3-7; Claim 1) Non-tagged items are never discussed.

Since Swartz does not even consider situations where an article does not have a tag, Swartz cannot possibly read on “a database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags and articles **not having attached security tags**” as explicitly recited in Applicant’s independent claims 1 and 16.

It is well established that, to support a *prima facie* case of obviousness, the combination of references must have all of the claimed limitations. Obviousness under §103 requires one to look at (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of skill in the art; and (4) any relevant objective evidence of obviousness or non-obviousness. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). Since, as discussed above in detail, Mason and Swartz, individually or combined, do not have all of the claimed features, Applicant respectfully submits that claims 1 and 16 are allowable over Mason, Swartz and the combination thereof.¹

Claims 2, 3, 6 and 8-15 are dependent on and include all of the limitations of claim 1. therefore, all of the above arguments made with respect to independent claim 1 are equally as applicable to claims 2, 3, 6 and 8-15. For at least this reason, Applicant respectfully submits that claims 2, 3, 6 and 8-15 are allowable over Mason, Swartz and the combination thereof.

¹ *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007) (“While the KSR Court rejected a rigid application of the teaching, suggestion, or motivation (‘TSM’) test in an obviousness inquiry, the Court acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does’ in an obviousness determination.”)

CONCLUSION

For the foregoing reasons, allowance of Claims 1-3, 6 and 8-16 is courteously urged.

If there remain any questions regarding the present Application, or if the Examiner has any further suggestions for expediting allowance of the present Application, the Examiner is cordially requested to contact the undersigned.

Please charge any additional fees for this Amendment or credit any overpayments to Deposit Account No. 50-0521.

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